

REMARKS

Reconsideration is requested.

The Examiner's allowance of claims 7-17, 22-23, 30-34 and 36-37 and indication that claims 2-5, 18-21, 27-29, 35, and 38 contain allowable subject matter are acknowledged.

The Abstract appearing on the Title Page of the issued patent, and the specification appearing at Column 1, line 18, and Column 8, line 30, have been amended to include the corrections made in the Certificate of Correction issued March 19, 2002.

In order to incorporate those corrections made in the Certificate of Correction issued March 19, 2002 (MPEP 1411.01), the paragraph at Col. 1, lines 11-18 and the paragraph at Col. 8, lines 25-33 have been amended.

The Specification has been amended to update the status of the patent applications mentioned in the specification.

Claims 1-37 are from the original patent.

The Examiner has objected to the Specification as failing to provide proper antecedent basis for the subject matter set forth in claims 6, 21 and 26 and has referred to the term modulator appearing in claims 6, 21 and 26. The paragraph at Col. 4, lines 13-20 has been amended to specifically recite the term modulator. Col. 4, lines 6-9 specify that "In the illustrated embodiment, the RFID circuitry is defined by an integrated circuit as described in the above-

incorporated patent application Ser. No. 08/705,043.” Support for the term “modulator” can be found, for example, in this incorporated application which specifies, for example, that “in the illustrated embodiment, the modulation scheme for replies sent by the transmitter 32 is selectable.” Therefore, the transmitter uses a modulation scheme and thus can be referred to as a modulator.

Claims 1, 34, 38, 42, 49-57 and 67 have been amended in the manner suggested by the Examiner in Paragraph 2 of the instant Action.

Claims 18-21, 24-29, 35, 39-57 and 73-74 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter of the invention.

Claims 18-20 have been amended. The amendment of claim 18 addresses the issue that the Examiner raised with claim 21.

Claim 24 has been amended to delete “different” and “multiple” before “wireless identification devices”.

Claim 27 has been amended to change “receiver” to --interrogator--. Support can be found in claim 16 and 17.

Claim 35 has been amended to recite that the interrogator is configured to input and store a number representing the specified group. Support can be found in Col. 9, last line, to Col. 10, line 5.

Claims 39 and 49 have been rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps. The Examiner has indicated that the omitted steps are steps in which information obtained from the first request is used to perform the starting step.

The Examiner is mistaken. No such steps have been disclosed as being essential. 35 U.S.C. 112 states that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise and exact terms, as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. There is no requirement that the claims be limited to the exact embodiments described in the Detailed Description. Claims are not to be rejected as broader than the enabling disclosure under 35 U.S.C. 112 for noninclusion of limitations dealing with factors which must be presumed to be within the level of ordinary skill in the art; the claims need not recite such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious. *In re Skrivan*, 427 F.2d 801, 806, 166 USPQ 85, 88 (CCPA 1970). One does not look to the claims but to the specification to find out how to practice the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558, 220 USPQ 303, 316-17 (Fed. Cir. 1983); *In re Johnson*, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977). In *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976), the

court stated:

[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

It is respectfully submitted that one of ordinary skill in the art would have no problem understanding that an arbitration scheme is being claimed. However, for increased clarity, the term "arbitration" has been added.

Claims 50 and 52 have been rewritten to refer to "arbitration tree search," for which there is clear support in claim 49, instead of "tree search scheme."

Claim 53 has been rewritten to depend on claim 51, as suggested by the Examiner.

Claims 55 and 56 have been rewritten to specify "first subgroup" instead of "the plurality."

Claim 73 has been rewritten to depend on claim 69, as suggested by the Examiner.

Claims 1-75 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-41 of U.S. Patent No. 6,118,789. Enclosed herewith is a Terminal Disclaimer which obviates this rejection.

Claims 1, 6, 24-26, 39-46, 49-54, 58-59, 61-64, 67, 69-72 and 75 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,583,850 to Snodgrass et al.

This rejection is respectfully traversed. Contrary to the Examiner's assertion, the Snodgrass et al. reference fails to teach or suggest starting a tree search at a selectable level of the search tree, in combination with the other elements of the claims.

Instead, the Snodgrass et al. reference teaches always starting a tree search at the top node. See, for example, Fig. 12, and text starting at Col. 16, line 22; and, more particularly, text starting at Col. 17, line 53 of the Snodgrass et al. reference.

By knowing the maximum number of devices that are in the field (that can communicate with the interrogator), and starting an arbitration search scheme at a point in response to that number, the number of collisions are reduced, thus resulting in reduced arbitration time, as discussed in applicant's specification.

This issue is not addressed by the Snodgrass et al. reference and no solution is taught.

Therefore, the rejection is improper and should be withdrawn.

Claims 47-48, 55-57, 65-66 and 73-74 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,583,850 to Snodgrass in view of U.S. Patent No. 6,038,455 to Gardner et al.

This rejection is respectfully traversed. It would not be obvious to substitute a portion of the structure of Gardner et al. for portions of the structure of Snodgrass because there is no teaching in the references themselves of how the components should be combined or of which components of Gardner et al. should be combined with which components of Snodgrass. There are no teachings in the references themselves which teach that there would be any advantage resulting from selecting portions of the structure of Gardner et al. and integrating that structure somehow into the structure of Snodgrass. The mere fact that the structures of the references could possibly be somehow modified to result in the claimed structure does not render the claimed structure obvious unless the references themselves suggest the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Evidence of a suggestion to combine may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999). No such evidence exists here.

Therefore, the rejection under 35 U.S.C. 103 is improper and should be withdrawn.


Appl. No. 10/693,696
Response to 9/13/05 Office Action
Atty. Dkt. MI40-364

A Statement of Status of Claims and Support in accordance with 37 CFR 1.174(c) is attached as a separate paper.

This application is believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: Dec 13, 2005

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Encl.: Statement of Status of Claims and Support